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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/624,733

**Applicant(s)**

KOBASHIKAWA ET AL.

**Examiner**

SHEW-FEN LIN

**Art Unit**

2166

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25, 28-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, 28-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

- a. This action is taken in response to amendments and remarks filed on 5/5/2008.
- b. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.
- c. Claims 1, 5, 9, 14, 16, 18, 19, 21, and 28 are amended. Claims 26 and 27 are cancelled. Claims 1-25, 28, and 29 are currently pending. Claims 1, 9, 16, 18, 21, and 28 are independent claims.

### ***Claim Objections***

Claim 1 recites the limitation "the application". There is insufficient antecedent basis for the limitation in the claim.

Claim 14 recites the limitation "the organization folder", "the electronic addresses book". There is insufficient antecedent basis for the limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 16, "an apparatus for using in..." is being cited. However, it appears that one of ordinary skill in the art could reasonably interpret the system as software, per se. As

defined in the specification, it is clear that each of the means is a software instruction to be executed (see Fig. 2, page 3, lines 12-27 of instant specification, i.e. scanning, filtering, adding) thus constitutes functional descriptive material. When functional descriptive material is recorded on some computer-readable medium, e.g. memory, and executable, e.g. by a processor, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. The claim lacks the components to enable the functions of the system to be realized and thus does not fall within any of the four statutory classes of 35 U.S.C. § 101.

Regarding claim 17 depends from rejected claim 16, comprises the same deficiencies as those claims directly or indirectly by dependence, and is therefore rejected on the same basis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, and 9-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya") in view of Huang (US Patent Publication 2003/0231207).

**As to claim 1**, Tafoya discloses a method/system/apparatus for use in populating an electronic address book (col. 2, lines 25-28, automatically tracks and maintains entries, such as contacts or email addresses and organizes and maintains the tracked entries in a dynamic resolution list), comprising:

Searching, over a network (Fig. 1, col. 6, lines 23-34, operate in a networked environment using logical connections to one or more remote computers), through at least one archive of e-mails for an e-mail address (Fig. 2, 210, 220, electronic mail stores), each of the at least one archive of e-mails being based on a different application from a first application used to initiate the searching (col. 6, lines, 55-67, col. 7, lines 23-36, The PIM scans [search] the data store from which it extracts email addresses and contact information that is weighted and used to initially populate a dynamic resolution list, database mail store listings located on local or public servers); to receive a first defined criteria communicated over the network from a client browser during a communication session with the first application (col. 10, lines 54-55, the criteria used to determine whether or not an entry should be added to the resolution list); and to create the electronic address book (Fig. 4D, col. 7, line 65 to col. 8, lines 9, adding or removing entries to or from the resolution list);

evaluating the e-mail address based on the first defined criterion (Figs. 4A-4D, col. 4, lines 57-65), which limits the selection of the e-mail address based on a prior communication action performed using the e-mail address (Fig. 4B, 414, col. 2, lines 56-57, col. 4, lines 59-60, col. 10, lines 8-11, previously sent and received email addresses); and

automatically adding the e-mail address to the electronic address book in a priority order based on the first defined criterion if the first defined criterion is satisfied (Figs. 4A, 4D, 450, 452, col. 4, lines 57-58.

Tafoya discloses wherein the e-mail address is added to a folder within the electronic address book (col. 7, lines 36-54, col. 11, lines 51-54, col. 12, lines 60-61) but does not explicitly disclose the folder is identified with the application that is associated with the at least one archive that is associated with the e-mail address.

Huang discloses the folder is identified with the application that is associated with the at least one archive that is associated with the e-mail address (Figs. 1-3, paragraph [0049]-[0050], a my-company folder 334, a my-MSN folder 336, a drafts folder 338, a sent items folder 340, a spam folder 342, a trash folder 344, a my-HOTMAIL folder 346, and a my-AOL folder 348. These let the user direct which folders and accounts 306-329 are accessed and how messages are to be responded to).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya's disclosure to identify the source of e-mail address as taught by Huang for the purpose of providing information about the source of message and organizing the address accordingly (Huang, Fig. 1). The skilled artisan would have been motivated to improve

the invention of Tafoya per the above such that the addresses are group based on the message category/domain (Huang, Fig. 3).

**As to claim 2**, Tafoya discloses the elements of claim 1 as noted above and further discloses wherein the searching includes searching an "From" field, a "to" field and a "cc" field (col. 7, lines 42-47, col. 10, lines 51-52, From, To, CC, BCC).

**As to claim 3**, Tafoya discloses the elements of claim 1 as noted above and further discloses wherein the evaluating includes determining if the e-mail address already exists in the electronic address book, and not adding the e-mail address in the electronic address book if it already exists in the electronic address book (col. 12, lines 4-19).

**As to claim 4**, Tafoya discloses the elements of claims 3 and 18 as noted above and further discloses wherein the evaluating includes evaluating the e-mail address based on a second defined criterion (Fig. 4A, 406, col. 8, lines 3-6, junk email filtering, either address or domain); and the adding includes adding the e-mail address to the electronic address book if both the first and the second defined criterion are satisfied and not adding the e-mail address to the electronic address book unless both the first and second criteria are satisfied (Figs. 4A-4D).

**As to claim 5**, Tafoya in view of Huang discloses the elements of claim 1 as noted above and further discloses determining if the at least one archive from which the e-mail address was retrieved includes an organization of emails (Huang, Fig. 3, paragraph [0013]); organizing the

electronic address book according to at least a portion of the organization of the at least one archive from which the e-mail address was retrieved (Huang, Fig. 3); and the adding includes adding the e-mail such that the e-mail address is added according to the organized address book (Huang, Fig. 3, paragraph [0050]).

**As to claim 6**, Tafoya discloses the elements of claim 1 as noted above and further discloses generating a retrieved list of e-mail addresses retrieved during the searching that satisfy the first defined criterion (Fig. 4A, 400, 402); and the adding includes adding the e-mail addresses if the e-mail address is confirmed to be added (Figs. 4A, 412, 430).

**As to claim 9**, Tafoya discloses a method for use in generating and maintaining an address book (col. 2, lines 25-28, automatically tracks and maintains entries, such as contacts or email addresses and organizes and maintains the tracked entries in a dynamic resolution list 2), comprising:

Accessing, over a network (Fig. 1, col. 6, lines 23-34, operate in a networked environment using logical connections to one or more remote computers), an electronic archive comprising a list of e-mail addresses generated with a first application (Fig. 2, 210, 220, electronic mail stores, col. 7, lines 23-36);

Parsing, over the network, the electronic archive for the e-mail addresses, based on the first application (col. 6, lines, 55-67, col. 7, lines 23-36, The PIM scans [search] the data store from which it extracts email addresses and contact information that is weighted and used to



initially populate a dynamic resolution list, database mail store listings located on local or public servers);

applying a first criterion to a first retrieved e-mail address(col. 10, lines 54-55, the criteria used to determine whether or not an entry should be added to the resolution list ), wherein the first criterion is received over the network from a client browser during a communication session (Figs. 2, 3, 4A-4D, col. 4, lines 57-65) with a different application that also generates the electronic address book and generates a different archive comprising a different list of email addresses (col. 7, lines 23-36), and wherein the first criterion limits the selection of the retrieved e-mail address based on a prior communication action performed using the retrieved e-mail address (Fig.4B, 414, col. 2, lines 56-57, col. 4, lines 59-60, col. 10, lines 8-11, previously sent and received email addresses); and

adding the first retrieved e-mail address to an electronic address book in a priority order based on the first criterion if the first criterion is met (Figs. 4A, 4D, 450, 452, col. 4, lines 57-58),.

Tafoya discloses wherein the e-mail address is added to a folder within the electronic address book (col. 7, lines 36-54, col. 11, lines 51-54, col. 12, lines 60-61) but does not explicitly disclose the folder is identified with the different application.

Huang discloses the folder is identified with the different application (Figs. 1-3, paragraph [0049]-[0050], a my-company folder 334, a my-MSN folder 336, a drafts folder 338, a sent items folder 340, a spam folder 342, a trash folder 344, a my-HOTMAIL folder 346, and a my-AOL folder 348. These let the user direct which folders and accounts 306-329 are accessed and how messages are to be responded to) and a different application that also generates the

electronic address book and generates a different archive comprising a different list of email addresses (Figs. 1-3).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya's disclosure to identify the source of e-mail address as taught by Huang for the purpose of providing information about the source of message and organizing the address accordingly (Huang, Fig. 1). The skilled artisan would have been motivated to improve the invention of Tafoya per the above such that the addresses are group based on the message category/domain (Huang, Fig. 3).

**As to claim 10**, Tafoya discloses the elements of claim 9 as noted above and further discloses wherein the applying includes applying a second criterion to the first retrieved address (Fig. 4A, 406, col. 8, lines 3-6, junk email filtering, either address or domain); and the adding includes adding the first retrieved address to the electronic address book if both the first and second criteria are met (Figs. 4A-4D).

**As to claim 11**, Tafoya discloses the elements of claim 10 as noted above and further discloses supplying a plurality of criteria options (Figs. 4A-4D).

**As to claim 12**, Tafoya discloses the elements of claim 10 as noted above and further discloses wherein the archive includes an archive of e-mails (Fig. 2, 210, 220, 230); and the parsing includes parsing a plurality of fields associated with each e-mail of the archive (col. 7, lines 42-47, col. 10, lines 51-52, From, To, CC, BCC).

**As to claim 13**, Tafoya discloses the elements of claim 10 as noted above and further discloses accessing, over the network, an external archive comprising a second list of e-mail addresses (Fig. 2, 220, 230) generated with a second application (Fig. 2, col. 7, lines 23-36); parsing the external archive for e-mail addresses (col. 6, lines 61-67); retrieving e-mail addresses from the external archive (col. 6, lines 61-67); applying the first and second criteria (Figs. 4A-4D); and adding the retrieved e-mail addresses from the external archive if the retrieved e-mail addresses from the external archives meet both the first and second criteria (Fig. 4D, 452).

**As to claim 14**, Tafoya in view of Huang discloses the elements of claim 12 as noted above and further discloses determining if the archive includes an organizational folder (Huang, Fig. 3, paragraph [0013]); determining if the e-mail address was retrieved from the organization folder (Huang, Fig. 3, paragraph [0013]), generating the folder within the electronic addresses book (Huang, Fig. 3, paragraph [0050]).

**As to claim 15**, Tafoya discloses the elements of claim 12 as noted above and further discloses generating a nickname in association with the first e-mail address (col. 7, lines 50-54); and adding the nickname associated with the first e-mail address to the address book (col. 7 lines 53-54, col. 8, lines 38-44).

**As to claim 16**, is directed to an apparatus carrying instructions for performing the methods of claim 1 and is rejected along the same rationale.

**As to claim 17**, is directed to an apparatus carrying instructions for performing the methods of claim 2 and is rejected along the same rationale.

**As to claim 18**, is directed to a computer readable medium carrying instructions for performing the methods of claims 1 respectively and therefore rejected along the same rationale.

**As to claim 19**, is directed to a computer readable medium carrying instructions for performing the methods of claims 4 respectively and therefore rejected along the same rationale.

**As to claim 20**, Tafoya discloses the elements of claim 19 as noted above and further discloses a code segment for supplying a plurality of criteria options (Fig. 4A); and a code segment for receiving a selection of criteria including the first and second criteria (Figs. 4A-4D).

**As to claim 21**, Tafoya discloses an apparatus for use in populating an electronic address book over a network (col. 2, lines 25-28, automatically tracks and maintains entries, such as contacts or email addresses and organizes and maintains the tracked entries in a dynamic resolution list), comprising:

a transceiver in communication with the network (Fig. 1, items 158, 160, col. 6, lines 35-41, network interface or modem to communicate with network);

a processor in communication with the transceiver (Fig. 1, items 102, 106, col. 5, lines 39-43, communicate through bus); and

a memory in communication with the processor (Fig. 1, items 104, 226, 128, 130), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

accessing, over the network (Fig. 1, col. 6, lines 23-34, operate in a networked environment using logical connections to one or more remote computers), a plurality of archives of e-mails for an e-mail (Fig. 2, items 210, 220, 230, col. 6, lines 55-61), each of the plurality of archives of e-mails being within a different one of a plurality of applications (col. 6, lines, 55-67, col. 7, lines 23-36, The PIM scans [search] the data store from which it extracts email addresses and contact information that is weighted and used to initially populate a dynamic resolution list, database mail store listings located on local or public servers);

parsing the e-mail to obtain an e-mail address based at least in part on a first one of the plurality of applications that is associated with the e-mail (col. 6, lines 61-67, col. 7, lines 23-36, retrieve email address from data store), and to determine a relevance rating for the email address based on whether language in the e-mail that is utilized in outgoing e-mails in a selected user's archive of outgoing e-mails (Fig. 4B, col. 10, lines 28- 42, calculate weight [relevance rating] include the number of times that the email address or contact has been used for sending, sent usage frequency, "language in the e-mail" is interpreted as "style in the e-mail", as such, "the email address based on whether language in the e-mail is utilized in outgoing e-mails" is interpreted as "e-mail address of outgoing e-mail"), that is within a second one of the plurality of applications (col. 7, lines 26-35, col. 10, lines 8-11);

automatically adding the e-mail address to the electronic address book (Figs. 4C, 4D, 440, col. 12, lines 45-64, add to resolution list when email address matches criteria) in a priority

order based on the relevance rating (Figs. 4C, 4D, col. 4, lines 57-58, col. 12, lines 51-64, address is ordered based on weight [relevance rating]), and

providing to a user device, over the network, an access to the electronic address book (col. 2, lines 33-35, user can save or edit the list, col. 5, lines 28-33, PIM module with resolution list may be located remote in a distributed computing environment, i.e. user interface access the resolution list, over the network).

Tafoya discloses wherein the e-mail address is added to a folder within the electronic address book (col. 7, lines 36-54, col. 11, lines 51-54, col. 12, lines 60-61) but does not explicitly disclose the folder is identified with first one of the plurality of applications that is associated with the e-mail.

Huang discloses the folder is identified with first one of the plurality of applications that is associated with the e-mail (Figs. 1-3, paragraph [0049]-[0050], a my-company folder 334, a my-MSN folder 336, a drafts folder 338, a sent items folder 340, a spam folder 342, a trash folder 344, a my-HOTMAIL folder 346, and a my-AOL folder 348. These let the user direct which folders and accounts 306-329 are accessed and how messages are to be responded to).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya's disclosure to identify the source of e-mail address as taught by Huang for the purpose of providing information about the source of message and organizing the address accordingly (Huang, Fig. 1). The skilled artisan would have been motivated to improve the invention of Tafoya per the above such that the addresses are group based on the message category/domain (Huang, Fig. 3).

**As to claim 22**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency (Fig. 4B, 416, 418, 420, col. 12, lines 20-30) the e-mail address is similar to another e-mail address (Fig. 4C, 434), or a date associated with the e-mail address meets a threshold (col. 8, lines 57-60).

**As to claim 23**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the electronic address book is stored at least on one of the user device (col. 2, lines 33-35), the apparatus, or another network device.

**As to claim 24**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein at least one of the plurality archives of e-mails is stored on the apparatus, the user device (col. 7, lines 30-31, database mail store located in local,), or another network device (Fig. 2, items 210, 220, 230).

**As to claim 25**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the parsing further comprises sending a parsing instruction to cause remote parsing of the e-mail on a network device which stores the plurality of archives of e-mails (col. 7, lines 23-36, access data store to extract email address).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya and Huang as applied to claim 1 above, and further in view of Creswell et al. (US Patent 6,564,264, hereinafter "Creswell").

**As to claim 7**, Tafoya and Huang disclose the elements of claim 1 as noted above but do not explicitly disclose generating a verification list of at least the e-mail address added to the address book

Creswell discloses verifying the user with message with the updated address information (Figs. 2 and 3, col. 2, lines 48-55, lines 63-64, col. 4, lines 51-57).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya and Huang 's disclosure to include verification of updated e-mail address as taught by Creswell for the purpose of confirmation of updated e-mail address (Fig. 3, item 307, Creswell). The skilled artisan would have been motivated to improve the invention of Tafoya and Huang per the above such that added address book can be verified.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya and Huang as applied to claim 6 above, and further in view of Harms et al. (US Publish 2003/0078981, hereinafter "Harms").

**As to claim 8**, Tafoya and Huang disclose the elements of claim 6 as noted above but does not explicitly disclose receiving confirmation of additions based on the retrieved list prior to the adding the e-mail address.



Harms discloses selecting contacts to add the e-mail address (Fig. 4, paragraph [0027], paragraph [0033]).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya and Huang 's disclosure to include selecting box next to the search results as taught by Harms for the purpose of identifying which e-mails are to be added (paragraph [0033], Harms). The skilled artisan would have been motivated to improve the invention of Tafoya and Huang per the above such that the user can selectively update the contact list based on search results .

Claim 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que ("Special Edition Using Microsoft Outlook 2002", Publisher Que, June, 2001) in view of Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya"), and further in view of Huang.

**As to claim 28**, Que discloses an apparatus for use in populating a destination electronic address book over a network (import message and address book from applications, Fig. 18.2, page 18-2), comprising: a transceiver in communication with the network; a processor in communication with the transceiver; and a memory in communication with the processor (connect and exchange information with network by any computer, page 2-2), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

accessing a first source electronic address book for a first e-mail address that is also associated with a first phone number (import address book from different Internet Mail applications, Figs. 18.1, 18.2, page 18-4, note that information in the address book typical including name, e-mail, phone number as shown in page 7-29 for vCard, Outlook Express and other), the first source electronic address book comprising a list of e-mail addresses generated with a first application that is different from a destination application used to generate the destination electronic address book (address book from another messaging application, pages 18-3 to 18-4);

evaluating the e-mail address based on a first defined criterion (import option, such as "Do not import duplicate items", Fig. 18.3) that includes a frequency with which the e-mail address is detected in an archive of e-mails that are associated with the destination electronic address book; and

adding the e-mail address and the phone number to the destination electronic address book if the first defined criterion is satisfied (pages 18-3 to 18-4), wherein the e-mail address and phone number are added in a priority order based on the first defined criterion into a folder of the destination electronic address book that is associated with the first defined criterion and is identified with the first application.

Que discloses evaluating the e-mail address based on a first defined criterion but does not explicitly disclose a first defined criterion that includes a frequency with which the e-mail is detected in an archive of e-mails that are associated with the destination electronic address book and wherein the e-mail address and phone number are added in a priority order based on the first

defined criterion into a folder of the destination electronic address book that is associated with the first defined criterion.

Tafoya, however, discloses a first defined criterion that includes a frequency with which the e-mail is detected in an archive of e-mails that are associated with the destination electronic address book (Fig. 4B, col. 8, lines 52-55, the number of times that mail has been sent to and/or received from a particular address or contact is preferably used in determining the weight assigned to an entry in the resolution list, i.e. address book) and wherein the e-mail address and phone number are added in a priority order based on the first defined criterion into a folder of the destination electronic address book that is associated with the first defined criterion (Fig. 4D, col. 12, lines 51-64, add entry to the resolution list [address book] if this element's weighting adequate, i.e. based on priority order)

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Que's disclosure to add e-mail address to address book based on the number of times that a particular address is used as taught by Tafoya for the purpose of keeping frequently used email address and contacts (col. 13, lines 30-36, Tafoya). The skilled artisan would have been motivated to improve the invention of Que per the above such that addresses with high weights (frequency of use) can initiate a prompt to the user to suggest adding to the contact of the user's address book (col. 13, lines 62-64, Tafoya).

Combination of Que and Tafoya teaches a folder of the destination electronic address book that is associated with the first defined criterion (Tafoya, Figs. 4A, 4D, 450, 452, col. 4, lines 57-58, col. 7, lines 36-54, col. 11, lines 51-54, col. 12, lines 60-61 ) but does not explicitly disclose is identified with the first application.

Huang discloses the folder is identified with the first application (Figs. 1-3, paragraph [0049]-[0050], a my-company folder 334, a my-MSN folder 336, a drafts folder 338, a sent items folder 340, a spam folder 342, a trash folder 344, a my-HOTMAIL folder 346, and a my-AOL folder 348. These let the user direct which folders and accounts 306-329 are accessed and how messages are to be responded to).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tafoya's disclosure to identify the source of e-mail address as taught by Huang for the purpose of providing information about the source of message and organizing the address accordingly (Huang, Fig. 1). The skilled artisan would have been motivated to improve the invention of Tafoya per the above such that the address is group based on the message category/domain (Huang, Fig. 3).

**As to claim 29**, Que discloses the elements of claim 28 as noted above and further discloses wherein the actions further comprising:

accessing a second source electronic address book for a second e-mail address, the second source electronic address book comprising a list of e-mail addresses generated with a second application (importing from Outlook Express or another message application, pages 18-3 to 18-4);

evaluating the second e-mail address based on the first defined criterion (import option, such as "Do not import duplicate items", Fig. 18.3); and

adding the second e-mail address to the destination electronic address book if the first defined criterion is satisfied (pages 18-3 to 18-4).

***Response to Amendment and Remarks***

Applicant's arguments based on newly amended features have been fully and carefully considered but are moot in view of the new ground(s) of rejection. Refer to the corresponding sections of the claim analysis for details.

Applicant argues that , the specification states that the "system 120 includes a host 126 that can be implemented through a computer, a plurality of computers..., one or more processors or a combination of computers, servers and/or processors 130." Spec., pg. 8, lines 1-5. ... The controller 180 can be configured to control the data flow and operation of the components of the address book builder." Spec., pg. 10, lines 18-23. Thus, at the very least, the components are in a computer memory and executable by microprocessor 180.

The Examiner respectfully disagrees.

The 101 Rejection is still maintained as shown above. The claimed "scanning", "filtering", and "adding" in claim 16 appears to be a "computer program per se", computer programs not embodied in a proper computer readable medium are not statutory. See MPEP 2106. Further, in view of specification, Examiner does not find physical **recital of structure** as a means or step for performing the specified function. Thus, the claimed subject matter falls outside all of the statutory categories.

Applicant argues that Tafoya does not discloses the limitations of determine a relevance rating for the email address based on whether language in the e-mail is utilized in outgoing e-mails because an e-mail address is not equivalent to, or encompassed within the phrase "language in the e-mail".

The Examiner respectfully disagrees.

Applicant is reminded that the Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. During patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’ Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). In this case, first, the claim as it is written is completely silent as to the definition of “language in the e-mail”. Furthermore, the specification does not provide clearly definition for “language in the e-mail”. The Examiner respectfully submits that the meaning of the term “language” can be interpreted as “style” (see Thesaurus.com, Synonym Collection v1.1), and “language in the e-mail” could be reasonable interpreted as ”style in the e-mail”, as such, “the email address based on whether language in the e-mail is utilized in outgoing e-mails” is equivalent to “e-mail address of outgoing e-mail”.

### ***Conclusion***

Applicant’s amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shew-Fen Lin /S. L./

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Examiner, Art Unit 2166

August 1, 2008

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169